

STATUS OF THE CLAIMS

Claims 1-9, 14, 17, 19-22, 24-31, 34, 36, 38, 42-45, 47, 49, and 89-91 are presently pending. Claims 10-13, 15, 16, 18, 23, 32-33, 35, 37, 39-41, 46, 48, and 50-88 were previously cancelled.

Claims 1-2, 9, 14, 17, 19-21, 24-27, 29-31, 34, 36, 38, 42-45, 47, 49, and 90 stand rejected under 35 U.S.C. § 103(a) as obvious over combinations of Goetz et al. (U.S. Pat. No. 6,421,650) in view of Lion (U.S. Pat. No. 6,330,491) and further in view of Engelson et al. (U.S. Pat. No. 6,671,536).

REMARKS

Applicant notes that Claims 1-2, 9, 14, 16, 17, 19-21, 24-27, 29-31, 34, 36, 38, 42-45, 47, 49 and 90 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz et al. (U.S. Patent No. 6,421,650, “Goetz”) in view of Lion (U.S. Patent No. 6,330,491, “Lion”), and further view of Engelson et al. (U.S. Patent No. 6,671,563, “Engelson”). Claims 3-8, 22, and 28 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion, in view of Engelson, and further in view of Edelson et al. (U.S. Patent No. 5,737,539, “Edelson”). Claims 89 and 91 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Simcox et al. (U.S. Patent No. 5,992,890, “Simcox”), and further in view of Engelson. Applicant traverses these rejections for at least the following reasons.

35 U.S.C. § 103(a) Rejections

Claims 1-2, 9, 14, 16, 17, 19-21, 24-27, 29-31, 34, 36, 38, 42-45, 47, 49 and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion and further in view of Engelson. Claims 3-8, 22, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion, in view of Engelson and further in view of Edelson. Claims 89 and 91 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Simcox, and in further view of Engelson. Claims 1, 20, 25, 36, 38, 45, 47, 49, 89, and 91 are independent claims. Claims 2, 9, 14, 17, 19, 21, 24, 26-27, 29-31, 34, 42-44, and 90 accordingly each depend from one of the above independent claims.

35 U.S.C. § 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish obviousness, the scope and content of the prior art must first be determined. Second, the differences between the prior art and the claims at issue must be ascertained. Third, the level of ordinary skill in the relevant art must be determined. Finally, taking this background

into consideration, the obviousness of the subject matter is determined. Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., can be utilized to determine the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), M.P.E.P. § 2141.

The Examiner has sought to demonstrate the obviousness of the claimed invention by combining those references to substantiate disclosure of each of the limitations of the claims. References may be combined when there exists a teaching or suggestion to combine the references to arrive at the claimed invention. While the Supreme Court has loosened the teaching/suggestion/motivation requirement, each limitation must still be somewhere disclosed, and there still must be some reason for combining the references (i.e., the references are all in the same field in which the function was made, such that they would be known to a person of ordinary skill in the art to which the invention pertains).

Claim 1 of the present invention relates to prescriptions, and, more particularly, to systems and methods for overriding a drug use evaluation alert, for capturing a reason for overriding a drug use evaluation alert, and for capturing and transmitting to a pharmacy or a claims processor a reason why a drug is to be dispensed as written. Claim 1 as currently presented requires that a prescribing physician, while actively involved in the task of prescribing medication, articulate and enter a reason for overriding a drug use evaluation alert via the graphical user interface provided by the electronic prescription device, thus, alleviating the need for prescriber verification of drug use evaluation alerts. Similarly, independent claims 20, 25, 36, 38, 45, 47, 49, 89, and 91 require that a prescribing physician, while actively involved in the task of prescribing medication, articulate and enter a reason for overriding a drug use evaluation

alert via the graphical user interface provided by the electronic prescription device, thus, alleviating the need for prescriber verification of drug use evaluation alerts. The rejection of independent claims 1, 20, 25, 30, 45, 47, 49, 89, and 91 are discussed further below.

The Examiner considered Applicant's arguments filed on February 4, 2009 but did not find them to be persuasive (Office Action at 24). Specifically, the Examiner stated that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references" and that "Goetz teaches receiving an override from a prescribing physician" while "Engelson was relied upon to teach receiving a reason for overriding an alert." (Office Action at 24-25).

At the outset, the Examiner has failed to indicate why Engelson should be considered a valid reference. Applicant has previously argued that in order for Engelson to be considered a valid reference, it must be a reference that a person of ordinary skill in the art would consider, with respect to the claimed invention. Engelson is directed towards administration tracking of medication administration in a hospital (i.e., making sure that nurses timely provide medications prescribed and filled by others,) not the decisions underlying the actual and medically substantive prescribing of medication. Thus Engelson is not a reference that a person of ordinary skill of prescription fulfillment would consider.

Goetz simply teaches receiving an over-ride from a prescribing physician, in the form of a "cancel" or "prescribe" query when a drug interaction is noted by the software. There is no disclosure of any actions subsequent to the physician entering prescribe into the physicians device, and accordingly, there is no disclosure of requiring the physician to enter a basis for the over-ride into the device. Accordingly, it is clear that Goetz alone does not teach the present invention.

The Examiner next argues that Engelson teaches this missing element, i.e., receiving a basis for an over-ride of a prescription alert into the physician's device. Even if Engelson were a valid reference, Engelson teaches no such thing. Engelson only teaches requiring a nurse to provide a reason why medication was not administered on time, and accordingly does not suggest the requirement of providing a substantive reason for an over-ride of a medical decision prior to the prescription of the medication, but rather simply allows the nurse to indicate that a patient did not receive their medication on time for some other reason (i.e., the patient was away from the room at the time the medication was to be administered). Accordingly, Engelson also does not teach the limitation of receiving from the physician a basis for over-riding a drug interaction alert.

While the Examiner contests that Applicant is merely attacking references individually, the argument is specious. Applicant is simply taking the references in order, and noting that the limitations not present in either reference. By first demonstrating that the limitation is not taught in Goetz, and then demonstrating that the limitation is not taught in Engelson, Applicant has demonstrated that neither reference discloses the limitation. In the absence of the limitation being taught in either reference, it does not matter whether the references are combined, as the combination is incapable of teaching a limitation that is not taught by either reference individually. Accordingly, the present invention as claimed in claim 1 is not obvious over Goetz in view of Engelson, because neither reference teaches the limitations of claim 1. Claims 2, 14, 17, and 19 are each dependent on claim 1, and accordingly incorporate each of the limitations of claim 1, and thus cannot be obvious where the independent claim is not obvious. Claims 3-9 are also dependent on claim 1, and accordingly incorporate each of the limitations of claim 1.

Claims 21, 22, 24-29, 30, 31, 34, 40, 42-44, and 90 are each claims dependent independent claims asserting this same limitations as in claim 1, and the Examiner's rejection is similarly inapt.

Therefore, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) with respect to claims 1, 20, 25, 30, 45, 47, 49, 89, and 91 be withdrawn.

CONCLUSION

Applicant respectfully submits that this application is not in condition for allowance and Applicant respectfully requests the same at the earliest possible time.

Respectfully Submitted,



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Carl H. Pierce
Registration No. 45,730
Joseph Miller, III
Registration No. 61,748
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103
(215) 851-8100
Attorneys for Applicant